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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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01/16/2004

Jordi Alborno

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10/10/2006

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EXAMINER

ALAM, SHAHID AL

ART UNIT

PAPER NUMBER

2162

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/759,965	Applicant(s) ALBORNOZ ET AL.	
	Examiner Shahid Al Alam	Art Unit 2162	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-22 is/are rejected.
- 7) ☒ Claim(s) 10, 14 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01162004</u> .  | 6) <input type="checkbox"/> Other: ____.                          |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 – 9, drawn to a method for creating a new annotation and a new annotation record is added to an annotation data store, classified in class 715, subclass 512.
  - II. Claims 10 – 22, drawn to a method for carrying forward annotations to a data source when the data source is modified and the annotation data stored is queried for the annotation that apply to the prior version of the data source, classified in class 707, subclass 203.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions as listed in Group I and Group II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination of Group II has separate utility such as the annotation data stored is queried for the annotation that apply to the prior version of the data source.

See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR

1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Stephen Bongini, Reg. No. 40,917 on 18 September 2006 a provisional election was made without traverse to prosecute the invention of Group II, claims 10 – 22. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1 – 9 are withdrawn from further

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consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Objections***

3. Claims 10, 14 and 16 are objected to because of the following informalities:

In the steps of claims 10, 14 and 16, claiming "generating or retrieving", it is not clear as to which portion of the limitation needed to be considered.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 10 – 22 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application 6,799,298 issued to Arjen deVries et al. (hereinafter “deVries”).

With respect to claim 10, deVries teaches a method of carrying forward annotations to a data source when the data source is modified, each of the annotations being stored as an annotation record in an annotation data store(see Figure 7, item 126), the method comprising the steps of:

generating a first data source version identifier based on a prior version of the data source; generating a second data source version identifier based on a modified version of the data source (see Figures 7, 8 and 10; column 15, lines 27 – 34, 61 – 63 and column 16, lines 48 – 58);

querying the annotation data store for the annotations that apply to the prior version of the data source (column 8, lines 20 – 22); and

adding a new entry into the annotation record of each relevant annotation that is returned by the query, the new entry in the annotation record including the second data source version identifier and point information indicating coordinates of at least one part of the modified version of the data source that this annotation is meant to annotate (column 15, lines 10 – 23 and 61 – 66).

As to claim 11, filtering the annotations that are returned by the query so as to remove any annotation that is not relevant to the modified version of the data source (column 19, lines 22 – 27).

As to claim 12, the filtering step includes the sub-step of determining whether each annotation that is returned by the query is relevant or not relevant to the modified version of the data source based on the point information stored in the annotation data store for that annotation (column 19, lines 22 – 27).

As to claim 13, the annotation record for each annotation includes an identifier list and the text of the annotation, and the identifier list includes one or more list entries, each list entry comprising one data source version identifier and point information (column 16, lines 46 – 58 and column 17, lines 7 – 13).

As to claim 14, the step of generating a second data source version identifier comprises the sub-steps of: using a hashing algorithm to calculate a substantially unique hash value for the modified version of the data source; and assigning the hash value as the second data source version identifier (column 16, lines 46 – 58).

As to claim 15, calculating the point information or the modified version of the data source from the point information stored in the annotation data store for the prior version of the data source (column 16, lines 46 – 58 and column 17, lines 7 – 13).

Claims 16 – 19 are essentially the same as claims 10 – 15 except that it sets forth the claimed invention as a computer program product rather than a method and rejected for the same reasons as applied hereinabove.


Claims 20 – 22 are essentially the same as claims 10 – 15 except that it sets forth the claimed invention as a system rather than a method and rejected for the same reasons as applied hereinabove.

**Conclusion**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahid Al Alam whose telephone number is (571) 272-4030. The examiner can normally be reached on Monday-Thursday 8:00 A.M.- 4:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Shahid Al Alam  
Primary Examiner  
Art Unit 2162

30 September 2006